

REMARKS

It is noted that the Examiner has made her action of November 26, 2003 final all be it this is the first action on the previously filed RCE application. In fact the Examiner has acted in her action of November 26, 2003 on the claims that she had amended in an Examiner's Amendment prior to issuing a Notice of Allowance in this case. The Notice of Allowance had been subsequently been withdrawn and the above-mentioned action was issued.

Claims 1, 17, 18-22, 24 and 25 now stand rejected under 35 U.S.C. 112 first paragraph as allegedly not being supported in the present specification. Applicant however submits that those skilled in the art would find enabling the section stating that the preferred surfactants act synergistically with other surfactants so that inclusion of a second surfactant as a co-surfactant can reduce the total amount of surfactant needed, without lose or effectiveness in enabling dispersion into an emulsion or micro emulsion. Applicant submits that those skilled in the art would appreciate the synergism of this statement. However, Applicant never did amend the claims to introduce the term "synergism". This is in fact was introduced and suggested by the Examiner by the prior Examiner's Amendment. Although Applicant agreed at the time with the Examiner's suggestion, following a review of the specification and finding full support therefore, it was for the purpose of expediting this case to allowance. Applicant, therefore has removed the term "synergism" from the claims as a term identified by the Examiner. The independent claims now therefore do not include a synergistic mixture but merely a mixture of the two surfactants. It is submitted that those skilled in the art would find this enabling since the purpose of the two surfactants is clearly set out in the specification, to reduce the amount required in total. Full reconsideration is therefore requested.

Claims 1, 17, 18-22, 24 and 25 now stand rejected under 35 U.S.C. 112 first paragraph allegedly since the specification does not reasonably provide enablement for synergism induced from the mixture of the two surfactants. Applicant therefore has amended the claims to delete any reference to synergy, synergistic or synergism. Full reconsideration is respectfully requested.

We note that the PTO has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling. . . . Showing that the disclosure entails undue experimentation is part of the PTO's initial burden.

Staehelin v. Secher, 24 USPQ 2d 1513, 1516 (B.P.A.I. 1992)

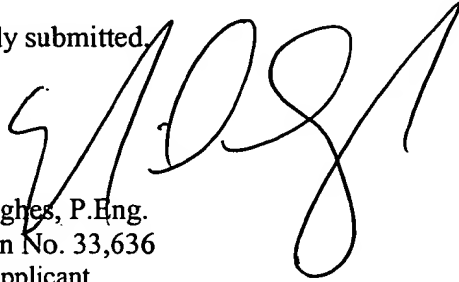
It has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement. . . . In satisfying the enablement requirement, an application need not teach, and preferably omits, that which is well-known in the art. . . . How such a teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 USC 112 unless there is reason to doubt the objective truth of the statements relied upon therein for enabling support. . . .

The error we see in Staehelin's approach to the question before us is that Staehelin would require a patent specification to be a blueprint which, if followed, would unfailingly reproduce exactly an applicant's claimed invention. However, the law does not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 USC 112, first paragraph.

Claims 1, 17, 18-22, 24 and 25 now stand rejected under 35 U.S.C. 103 as being unpatentable over Hauer, US patent 5,343,625. Applicant has very carefully reviewed Hauer in view of his own disclosure and has focused the claims to more specifically define that which Applicant seeks to protect by setting out specifically the preferred embodiments of the two surfactants which may be contained within the invention. Applicant has used the prior Examiner's amendments for making further amendments to the claims. Applicant submits that these specific preferred embodiments are not obvious from the teaching of Hauer and full reconsideration is respectfully requested. Applicant also has provided new claims 26 and 27 which also focus the invention to subject matter not taught in Hauer. The additional independent fee of \$86.00 is included herewith to cover the cost of filing an additional independent claim.

If the Examiner has any questions, she is respectfully requested to contact Applicants' Agent, Neil H. Hughes at (905) 771-6414 at her convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'N. Hughes', written over the 'Respectfully submitted,' text.

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Agent for Applicant

NHH:lvp
Enclosures